



UNITED STATES PATENT AND TRADEMARK OFFICE

RD

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/397,309	09/16/1999	JAMES L. BAUER	2854.72	8591

7590 02/24/2005

JAMES J MURTHA
ORRICK HERRINGTON & SUTCLIFFE LLP
666 FIFTH AVENUE
NEW YORK, NY 101030001

EXAMINER

GRAHAM, CLEMENT B

ART UNIT PAPER NUMBER

3628

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/397,309

Applicant(s)

BAUER ET AL.

Examiner

Clement B Graham

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-87 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-87 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-87 are remained pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action: (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 148 USPQ 459, that are applied for establishing a background for determining obviousness under 35 U.S.C.

103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating

obviousness or unobviousness.

4. Claim 1-22, are rejected under 35 U.S.C. 103(a) as being unpatentable over McMullin US Patent No.6, 222, 914).

As per claims 1, McMullin discloses providing a debit card ("i.e. debit card see column 2 line 15-40") to the user, wherein the debit card is associated with a financial account ("i. e, card holder account" see column 1 lines 16-38) such that the user may use the debit card to make purchases (See column 2 lines 15-40), and an amount corresponding, at least in part, to the cost of the purchase made using the debit card is debited to the financial account defining periods of time("i. e, billing cycle") (See column 3 lines 55-65 and column 4 lines 1-5 and line 25-30) providing a report ("i.e. bill" see column 3 lines 55-65) to the user. (see column 3 lines 55-65) at the end of each defined period identifying. ("i. e, monthly") at least in part, the purchases made with the debit card during the defined period. (see column 3 lines 55-65 and column 4 lines 5-30) designating a retailer as a preferred retailer. ("i. e, "sponsor" see column 2 lines 35-40") calculating a reward amount for the user based at least in part, on purchases made using the debit card during a current period (See column 7 lines line 35 and column 4 lines 25-30 and column 2 lines 45-59) and crediting the reward amount generated

Art Unit: 3628

during the current period to a user account. (See column 4 lines 25-30) and activating ("i. e, end of delay period") the user reward amount at the end of the current period. (See column 4 line 32-45) and debiting the amount of the cost of a purchase in a subsequent period from the financial account. (see column 3 line 65) and crediting ("i. e, payment") the financial account an amount up to the amount of the purchase("i. e, charge amounts") in the subsequent period from the activated user reward account for purchases made at the preferred retailer.(see column 1 lines 30-35).

Further McMullin fails to explicitly teach a reward account.

However McMullin states ("i. e, card holder account" see column 1 lines 16-38) and the incentive card administration calculates the award points earned by a participant at the end of each monthly billing cycle, and also states the participant have to wait for a delay period of before the reward account can be credited with the reward amount (see column 2 lines column 14-60) it would have been inherent that during the delay period the points accumulated would have had to be stored in an account prior to the rewarding of points to the debit card account.

Therefore it would have obvious to one of ordinary skill in the art at the time the invention was made that the teachings of McMullin would have been able to perform the function storing reward points in an account because, it would have been inherent that during the delay period the points accumulated would have had to be stored in an account prior to the rewarding of points to the debit card account.

As per claim 2, McMullin discloses wherein the debit card is issued by the financial institution and wherein the financial account is held by the financial institution. (see column 1 lines 50-65 and column 2 lines 35-65 and column 4 lines 5-45).

As per claim 3, McMullin discloses wherein the debit card is issued by a first financial institution and wherein the financial account is held by a second financial institution. .(see column 1 lines 50-65 and column 2 lines 35-65 and column 4 lines 5-45).

As per claim 4, McMullin discloses further comprising storing user reward amounts for periods prior to the current period .(see column 1 lines 50-65 and column 2 lines 35-65 and column 4 lines 5-45).

As per claim 5, McMullin discloses wherein the billing report at the end of the period includes a statement of the reward amount generated in periods prior to the period and not yet redeemed, the reward amount earned during the period, the reward amount redeemed during the period, and the total reward amount earned but not yet redeemed. (see column 1 lines 50-65 and column 2 lines 35-65 and column 4 lines 5-45).

As per claim 6, McMullin discloses wherein the billing report further includes a statement of the total reward amount generated in all periods.

As per claim 7, McMullin discloses further comprising displaying the logo of the financial institution on the debit card. (see column 1 lines 50-65 and column 2 lines 35-65 and column 4 lines 5-45).

As per claim 8, McMullin discloses further comprising displaying the logo of the preferred retailer on the debit card. (see column 1 lines 50-65 and column 2 lines 35-65 and column 4 lines 5-45).

As per claim 9, McMullin discloses wherein the preferred retailer comprises a plurality of retailers.

As per claim 10, McMullin discloses wherein the preferred retailer is an entity representing a plurality of distinct retailers. (see column 1 lines 50-65 and column 2 lines 35-65 and column 4 lines 5-45).

As per claim 11, McMullin discloses wherein the entity has a theme and the plurality of distinct retailers market goods or services related to theme. (see column 1 lines 50-65 and column 2 lines 35-65 and column 4 lines 5-45).

As per claim 22, McMullin discloses wherein the entity is a charitable institution. (see column 1 lines 50-65 and column 2 lines 35-65 and column 4 lines 5-45).

As per claim 13, McMullin discloses wherein the preferred retailer is the financial institution. (see column 1 lines 50-65 and column 2 lines 35-65 and column 4 lines 5-45).

As per claim 14, McMullin discloses comprising calculating the reward amount, at least, in part, as a percentage of the cost of purchases made at the preferred retailer by

Art Unit: 3628

the user using , the debit card. .(see column 1 lines 50-65 and column 2 lines 35-65 and column 4 lines 5-45).

As per claim 15, McMullin discloses further comprising calculating the reward amount, at least in part, as the sum of a first percentage of the cost of purchases made at the preferred retailer by the user using the debit card up to a first level of purchases and as a second percentage of the cost of purchases made at the preferred retailer by the user using the debit card up to a second level of purchases. (see column 1 lines 50-65 and column 2 lines 35-65 and column 4 lines 5-45).

As per claim 16, McMullin discloses further comprising calculating the reward amount, at least in part, as the sum of a first percentage of the cost of all purchases made by the user using the debit card and as a second percentage of the cost of purchases made at the preferred retailer by the user using the debit card. (see column 1 lines 50-65 and column 2 lines 35-65 and column 4 lines 5-45).

As per claim 17, McMullin discloses further comprising calculating the reward amount, at least in part, as the sum of a first percentage of the cost of all purchases made by the user using the debit card up to a first level of purchases and as a second percentage of the cost of purchases made at the preferred retailer by the user using the debit card up to a second level of purchases. .(see column 1 lines 50-65 and column 2 lines 35-65 and column 4 lines 5-45).

As per claim 18, McMullin discloses further comprising calculating the reward amount, at least in part, based on purchases of the designated goods made at the preferred retailer using the debit card. .(see column 1 lines 50-65 and column 2 lines 35-65 and column 4 lines 5-45).

As per claim 19, McMullin discloses further comprising calculating the reward amount, at least in part, as the sum of a first percentage of the cost of certain designated goods at the preferred retailer and as a second percentage of the cost of other purchases at the preferred retailer. .(see column 1 lines 50-65 and column 2 lines 35-65 and column 4 lines 5-45).

As per claim 20, McMullin discloses further comprising calculating the reward amount, at least in part, as a fixed amount for the purchase of designated goods made

Art Unit: 3628

at the preferred retailer using the debit card. (see column 1 lines 50-65 and column 2 lines 35-65 and column 4 lines 5-45).

As per claim 21, McMullin discloses wherein the reward account includes an activated component and a dormant component, and the financial account is credited for amounts up to the amount of purchases made by the user at the preferred retailer using the debit card from the activated component of the reward account up to the full amount of the active component.(see column 1 lines 50-65 and column 2 lines 35-65 and column 4 lines 5-45).

As per claim 22, McMullin discloses wherein the financial account is credited from the user reward account after the financial account is debited an amount of the cost of the purchase in the subsequent period.(see column 2 lines 35-55 and column 4 lines 5-45).

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 23-87 , are rejected under 35 U.S.C. 102(e) as being anticipated by McMullin US Patent No.6, 222, 914).

As per claims 23, McMullin discloses a system of reward management and tracking for a debit card reward program for a retailer in a-current period, including a user having a financial account with a financial institution and a debit card issued to the user and associated with the financial account such that the financial account is debited for purchases made by the user with the debit card, the system comprising. (see column 2 lines 35-55 and column 3 lines 55-65 and column 4 lines 5-45).

Art Unit: 3628

a computer memory means for storing data.(i. e, database see column 2 lines 45-55) and a computer processor.(“i. e, inherent with computers”) operably engaged to the computer memory means, the computer processor including:
current period.(see column 2 lines 35-55 and column 3 lines 55-65 and column 4 lines 5-45) means for storing identity of the user;
means for storing a reward earned by the user prior to the current period; means for calculating the reward earned by the user during the current period; means for activating the reward earned during the current period at the end of the
means for crediting the financial account an amount corresponding to a purchase made during the current period at a preferred retailer, up to an amount equal to the reward earned by the user prior to the current period.(see column 3 lines 55-65 and column 4 lines 5-45) and means for reducing the amount of the reward earned by the user prior to the current period by an amount corresponding to the amount that the financial account was credited.(see column 2 lines 35-55 and column 3 lines 55-65 and column 4 lines 5-45).

As per claims 24, McMullin discloses wherein the debit card is issued by the financial institution and wherein the financial account is administered by the financial institution.(see column 1 lines 45-65 and column 2 lines 35-55).

As per claims 25, McMullin discloses, wherein the debit card is issued by a first financial institution and wherein the financial account is administered by a second financial institution.(see column 2 lines 35-55)

As per claims 26, McMullin discloses further comprising means for storing user reward amounts for periods prior to the current period and a means for generating a billing report at the end of the current period including a statement of the reward amount generated in periods prior to the current period and not yet redeemed, the reward amount earned during the current period, the reward amount redeemed during the current period, and the total reward amount earned but not yet redeemed.(see column 1 lines 45-65 and column 2 lines 35-55).

As per claims 27, McMullin discloses wherein the billing report further includes a statement of the total reward amount generated in all periods.(see column 3 lines 40-65 and column 45-65).

As per claims 28, McMullin discloses wherein the logo of the financial institution is displayed on the debit card.(8 line 5-65).

As per claims 29, , McMullin discloses wherein the logo of the preferred retailer is displayed on the debit card.

As per claims 30, McMullin discloses wherein the preferred retailer comprises a plurality, of retailers.(see column 2 lines 35-55).

As per claims 31, McMullin discloses comprising means for calculating the reward earned by the user, at least in part, as a percentage of the cost of purchases made at the preferred retailer by the user using the debit card.(see column 4 lines 5-45).

As per claims 32, McMullin discloses further comprising means for calculating the reward earned by the user, at least in part, as the sum of a first percentage of the cost of purchases made at the preferred retailer by the user using the debit card up to a first level of purchases and as a second percentage of the cost of purchases made at the preferred retailer by the user using the debit card up to a second level of purchases.(see column 4 lines 5-45).

As per claims 33, McMullin discloses further comprising means for calculating the reward earned by the user, at least in part, as the sum of a first percentage of the cost of all purchases made by the user using the debit card and as a second percentage of the cost of purchases made at the preferred retailer by the user using the debit card.(see column 4 lines 5-45and column 3 lines 35-55).

As per claims 32, McMullin discloses further comprising a means for calculating the reward earned by the user, at least in part sum of a first percentage of the cost of all purchases made by the user using the debit card up to a first level of purchases and as a second percentage of the cost of purchases made at the preferred retailer by the user using the debit card up to a second level of purchases.

As per claims 35 , McMullin discloses further comprising means for calculating the reward earned by the user, at least in part, based on purchases of only designated goods made at the preferred retailer using the debit card.(see column 4 lines 5-45).

As per claims 36, McMullin discloses further comprising means for calculating the reward earned by the user, at least in part, as the sum of a first percentage of the cost of certain designated goods at the preferred retailer and as a second percentage of the cost of other purchases at the preferred retailer.(see column 2 lines 35-45 and column 4 lines 5-45).

As per claims 37 , McMullin discloses further comprising means for calculating the reward earned by the user, at least in part, as a fixed amount for the purchase of designated goods made at the preferred retailer using the debit card.(see column 4 lines 5-45 and column 2 lines 35-55).

As per claims 38 , McMullin discloses wherein the reward earned by the user includes an activated component and a dormant component, and the financial account is credited for amounts up to the amount of purchases made by the user at the preferred retailer using the debit card from the activated component of the reward earned by the user up to the full amount of the active component.(see column 1 lines 45-65 and column 2 lines 35-55 an column 3 lines 55-65 and column 4 lines 5-45).

As per claims 39 , McMullin discloses wherein the dormant component corresponds to amount earned in a current period, and wherein the dormant component is automatically activated at the end of the current period. (see column 1 lines 45-65 and column 2 lines 35-55 an column 3 lines 55-65 and column 4 lines 5-45).

As per claims 40-62, McMullin discloses providing a debit card to the user, wherein the debit card is associated with a financial account such that the user may use the debit card to make purchases and an amount corresponding, at least in part, to the cost of the purchase made using the debit card is debited to the financial account defining periods of time providing a report to the user at the end of each defined period identifying, at least in part, the purchases made with the debit card during the defined period designating a retailer as a preferred retailer interpretive as credit card users belonging to a selected issuer using a selected retailer and calculating a reward amount

Art Unit: 3628

for the user based at least in part, on purchases made using the debit card during a current period and, crediting the reward amount generated during the period to a user reward account, activating the user reward amount at the end of the period electing whether to provide the user reward amount to the sponsor or to the financial account, delivering the activated user reward amount to the sponsor when provision of the reward amount to the sponsor has been elected and debiting the amount of the cost of a purchase in a subsequent period from the financial account and crediting the financial account an amount up to the amount of the purchase in the subsequent period from the activated user reward account for purchases made at the preferred retailer when provision of the reward amount to the financial account has been elected.(see column 1 lines 45-65 and column 2 lines 35-55 and column 3 lines 35-65 and column 4 lines 5-45).

As per claims 63-85, McMullin discloses a method of operating a debit card reward program by a financial institution for a user comprising: providing a debit card ("i.e. debit card see column 2 line 35-40") to the user, wherein the debit card is associated with a financial account ("i. e, card holder account" see column 1 lines 16-38) such that the user may use the debit card to make purchases (See column 2 lines 15-40) at a point of sale to purchase goods, and an amount corresponding, at least in part, to the cost of the purchase made using the debit card is debited to the financial account.(See column 8 lines 30-45 and column 1 lines 20-40) defining selected parameters ("i. e, monthly") of information regarding each purchase made by the user predetermining levels of the selected parameters, capturing information regarding each purchase made by the user including(see column 3 lines 55-65 and column 4 lines 5-30"), at least in part, information concerning the selected parameters comparing the captured information to predetermined levels (see column 1 lines 25-38) calculating a reward based, at least in part, on the comparison of the captured information to the predetermined levels and delivering the reward . (See column 2 lines 45-59).

As per claim 86, McMullin discloses a method of operating a debit card reward program by a financial institution for a user in conjunction with a retailer, the method comprising:

Art Unit: 3628

providing a debit card to the user, wherein the debit card ("i.e. credit card see column 2 lines 35-40) is associated with a financial account such that the user may use the debit card to make purchases at a point of sale to purchase goods, and an amount corresponding, at least in part to the cost of the purchase made using the debit card is debited to the financial account (see column 2 lines 35-55)

defining a reward-generating activity in terms of selected characteristics of each purchase made by the user from the retailer using the debit card (see column 2 lines 35-55)

capturing transaction data regarding each purchase made by the user using the debit card including, at least in part, information concerning the selected characteristics, wherein the transaction data includes transaction financial information and transaction purchase information. (see column 2 lines 35-55)

wherein the transaction financial information relates, at least in part, to financial characteristics of each purchase made by the user from the retailer using the debit card(see column 2 lines 35-55)

wherein the transaction purchase information relates, at least in part, to particular goods sold at each purchase made by the user from the retailer using the debit card. (see column 2 lines 35-55) storing by the financial institution of transaction financial information related to each purchase made by the user from the retailer using the debit card. (see column 2 lines 45-550

storing by the retailer of transaction purchase information related to purchase made by the user from the retailer using the debit card;

comparing the transaction financial information and the transaction purchase information to the selected characteristics;

calculating a reward based, at least in part, on the comparison and

delivering the reward.(see column 2 lines 35-55 and column 3 lines 55-65 and column 4 lines 5-45).

As per claim 87. McMullin discloses a method of operating a financial service by a financial institution for a user comprising:

Art Unit: 3628

providing a debit card to the user, wherein the debit card is associated with a financial account such that the user may use the debit card to make purchases, and an amount corresponding, at least in part, to the cost of the purchase made using the debit card is debited to the financial account (see column 2 lines 35-55)

defining periods of time and designating at least one retailer as a preferred retailer; calculating a reward amount for the user based, at least in part, on purchases made using the debit card during a current period(see column 4 lines 5-45)

crediting the reward amount generated during the current period to a user reward account;

activating the user reward amount at the end of the current period.(see column 3 lines 55-65 and column 4 lines 5-45)

debiting the amount of the cost of a purchase in a subsequent period from the financial account and subsequently crediting the financial account an amount up to the amount of the purchase in the subsequent period from the activated user reward account for purchases made at the preferred retailer; and

providing a report to the user at the end of each defined period identifying, at least in part, the reward amount.9see column 7 lines 5-65).

Conclusion

Response to arguments

7. Applicant's arguments files on 11/05/04 have been fully considered but they are moot in view of new grounds of rejections.

8. In response to applicant's arguments regarding McMullin.

9. In response to Applicant's arguments that McMullin fail to teach or suggest" defining selected parameters of information regarding each purchase made by the user predetermining levels of the selected parameters, capturing information regarding each purchase made by the user including at least in part, information concerning the selected parameters comparing the captured information to predetermined levels calculating a reward based, at least in part, on the comparison of the captured information to the predetermined levels and delivering the reward and debiting the amount of the cost of a purchase for purchases made at the preferred retailer and

Art Unit: 3628

designating a retailer as a preferred retailer and debiting the amount of the cost of a purchase in a subsequent period from the financial account up to the amount of the purchase made at the preferred retailer means for crediting the financial account an amount corresponding to a purchase made during the current period at a preferred retailer”.

However these limitations are addressed as stated by McMullin discloses providing a debit card (“i.e. debit card see column 2 line 15-40”) to the user, wherein the debit card is associated with a financial account (“i. e, card holder account” see column 1 lines 16-38) such that the user may use the debit card to make purchases (See column 2 lines 15-40), and an amount corresponding, at least in part, to the cost of the purchase made using the debit card is debited to the financial account defining periods of time (“i. e, billing cycle”) (See column 3 lines 55-65 and column 4 lines 1-5 and line 25-30) providing a report (“i.e. bill” see column 3 lines 55-65) to the user. (see column 3 lines 55-65) at the end of each defined period identifying. (“i. e, monthly”) at least in part, the purchases made with the debit card during the defined period. (see column 3 lines 55-65 and column 4 lines 5-30) designating a retailer as a preferred retailer. (“i. e, “sponsor” see column 2 lines 35-40”) calculating a reward amount for the user based at least in part, on purchases made using the debit card during a current period (See column 7 lines line 35 and column 4 lines 25-30 and column 2 lines 45-59) and crediting the reward amount generated during the current period to a user account. (See column 4 lines 25-30) and activating (“i. e, end of delay period”) the user reward amount at the end of the current period. (See column 4 line 32-45) and debiting the amount of the cost of a purchase in a subsequent period from the financial account. see column 3 line 65 and crediting (“i. e, payment”) the financial account an amount up to the amount of the purchase (“i. e, charge amounts”) in the subsequent period from the activated user reward account for purchases made at the preferred retailer. see column 1 lines 30-35 and (“i. e, card holder account” see column 1 lines 16-38 and the incentive card administration calculates the award points earned by a participant at the end of each monthly billing cycle, and also states the participant have to wait for a delay period of

Art Unit: 3628

before the reward account can be credited with the reward amount see column 2 lines column 14-60 and operating a debit card reward program by a financial institution for a user comprising: providing a debit card ("i.e. debit card see column 2 line 35-40") to the user, wherein the debit card is associated with a financial account ("i. e, card holder account" see column 1 lines 16-38) such that the user may use the debit card to make purchases (See column 2 lines 15-40) at a point of sale to purchase goods, and an amount corresponding, at least in part, to the cost of the purchase made using the debit card is debited to the financial account.(See column 8 lines 30-45 and column 1 lines 20-40) defining selected parameters ("i. e, monthly") of information regarding each purchase made by the user predetermining levels of the selected parameters, capturing information regarding each purchase made by the user including(see column 3 lines 55-65 and column 4 lines 5-30"), at least in part, information concerning the selected parameters comparing the captured information to predetermined levels (see column 1 lines 25-38) calculating a reward based, at least in part, on the comparison of the captured information to the predetermined levels and delivering the reward . (See column 2 lines 45-59).

It is clear that the limitations addressed above are within the teachings of the prior art of reference.

10. The examiner apologized for using Walker as a reference but this was a typographical error on the examiner part.

11. Applicant's arguments that McMullin and obvious cannot be combined, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it

Art Unit: 3628

may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. In re Fine, 837 F.2d 1071, 5USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). See also In re Eli Lilli & Co., 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990) (discussion of reliance on legal precedent); In re Nilssen, 851 F.2d 1401, 7USPQ2d 1500 (Fed. Cir. 1988) (references do not have to explicitly suggest combining teachings); Ex parte Clapp, 227 USPQ 972 (Bd. Pat. App. & Inter); and Es parte

Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993) (reliance on logic and sound scientific reasoning).

Also in reference to Ex parte Levengood, 28 USPQ2d, 1301, the court stated that

"Obviousness is a legal conclusion, the determination of which is a question of patent law. Motivation for combining the teachings of the various references need not to explicitly found in the reference themselves, In re Keller, 642 F.2d 413, 208USPQ 871 (CCPA 1981). Indeed, the Examiner may provide an explanation based on logic and sound scientific reasoning that will support a holding of obviousness. In re Soli, 317 F.2d 941 137 USPQ 797 (CCPA 1963)."

12. With respect to Applicant's argument that the McMullin cannot be used to support a prima facie obviousness rejection, Examiner respectfully submits that obviousness is not determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See In re Oetiker, 977F. 2d 1443, 1445,24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Hedges, 783F.2d 1038, 1039, 228 USPQ* 685, 686 (Fed. Cir.1992); In re Piaseckii, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir.1984); In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Using this standard, the Examiner respectfully submits that he has at least satisfied the burden of presenting a prima facie case of obviousness, since he has presented evidence of corresponding claim elements in the prior art and has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention (See paper number 10). Note, for example, in the instant case, the Examiner respectfully notes that each and every motivation to combine the

Art Unit: 3628

applied references are accompanied by select portions of the respective reference(s) which specially support that particular motivation and /or an explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness. As such, it is not seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one of ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, Ex pane Levengood, 28 USPQ2d 1300(Bd. Pat. App &.4/293 Therefore the combination of reference is proper and the rejection is maintained.


12. The PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his [or her] claimed product. Whether the rejection is based on inherency' under 35 U.S.C. 102, on prima facie obviousness' under 35 U.S.C. 103, jointly or alternatively, the burden of proof is the same...[footnote omitted]." The burden of proof is similar to that required with respect to product-by-process claims. In re Fitzgerald, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980) (quoting In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977)).

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clement B Graham whose telephone number is 703-305-1874. The examiner can normally be reached on 7am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on 703-305-0505. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-0040 for regular communications and 703-305-0040 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

CG, February 2, 2005


FRANCIS DONNELL
PRIMARY EXAMINER
AU 3628